

35 U.S.C. § 112 Second Paragraph Rejection of Claims

In the 12 July 2006 Office Action the Examiner has rejected claims 35 - 68 under 35 U.S.C. §112 second paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter that is regarded as the invention. The Assignee will respectfully traverse the §112 second paragraph rejections of each claim in two ways. First, by noting that the Office Action has failed to establish a prima facie case that the specification does not meet the requirements of §112 second paragraph. Second, by noting that the claim rejections based on assertions of alleged indefiniteness are not in compliance with the Administrative Procedures Act and are therefore moot.

As mentioned previously, the Examiner has failed to establish a prima facie case that the specification does meet the requirements of §112 second paragraph for the rejected claims. It is well established that a prima facie case that a claim does not meet the requirements of §112 second paragraph requires that the claims be interpreted in light of the specification, that the claims be interpreted as one of ordinary skill in the art would interpret them, and that the Examiner show that limitation(s) in the claim do not reasonably define the invention. As detailed below, the Examiner has failed to establish a prima facie case that the specification does not meet the requirements of §112 second paragraph in as many as three ways for every rejected claim. The three ways are: by failing to interpret the claims in light of the specification, by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims (see Information Disclosure Statement portion of the remarks for more information) and/or by failing to establish that the limitation(s) in the claims fail to describe the invention. The table below shows the claim limitations the Examiner has questioned and the traversal(s) of the claim rejections with that limitation.

Claims	Limitation at issue	Claim rejection traversals include:
35 and elsewhere	Identifying an impact of each feature on one or more expected process outputs	1) failure to interpret claims in light of specification, 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately

Claims	Limitation(s) at issue	Failure modes include:
Unspecified	How mapping the expected process outputs to matrices of value and risk is accomplished	1) failure to interpret claims in light of specification, 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately
Unspecified	What is being simulated	1) failure to interpret claims in light of specification, 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately
Unspecified	How risk is measured and/or determined	1) failure to interpret claims in light of specification, 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately
Unspecified	How value is measured and/or determined	1) failure to interpret claims in light of specification 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately
Unspecified	All the different options, how are they determined?	1) failure to interpret claims in light of specification 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately
Unspecified	Automated learning?	1) failure to interpret claims in light of specification 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately

Claims	Limitation at issue	Failure modes include:
Unspecified	Operating factor data scope	1) failure to interpret claims in light of specification 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately
Unspecified	Use of simulation data	1) failure to interpret claims in light of specification 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately
Unspecified	How a real option segment of value defined a risk matrix	1) failure to interpret claims in light of specification 2) failure to provide evidence that someone of average skill in relevant arts would have difficulty, and 3) failure to provide evidence that invention not described adequately

As noted previously, the second way the Assignee will respectfully traverse the §112 second paragraph rejections of claims 35 - 68 is by noting that the assertions regarding the alleged indefiniteness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of PTO findings are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Assignee respectfully submits that discussion in the preceding paragraphs clearly shows that the instant Office Action fails to provide even a scintilla of evidence to support the allegation that the claims do not meet the requirements of §112 second paragraph and that as a result it fails to meet the substantial evidence standard. The Assignee respectfully submits that the 12 July 2006 Office Action also fails to pass the arbitrary and capricious test because the Examiner has not provided any evidence of relevant fact finding that can be connected to the rejections contained in the Office Action. The Assignee notes that there are still other ways in which these rejections can be shown to be arbitrary and capricious. Most notable among these is the fact that process simulation and process optimization patent applications and patents are generally classified as artificial intelligence applications (class 706) and that this patent application is being examined by an art unit that does not have any identified

expertise in artificial intelligence.

Furthermore, the Assignee reserves the right to provide a declaration that would provide a complete rebuttal of the arbitrary and capricious rejections contained in the 12 July 2006 Office Action regarding the indefiniteness of claims 35 – 68 in the event the Examiner is able to establish a prima facie case to support the claim rejections.

Request for information under 37 C.F.R. 1.105

The 12 July 2006 Office Action contains an unsubstantiated statement to the effect that an issue of public use or sales activity has been raised in this application. This unsubstantiated allegation is then coupled with a request under 37 C.F.R. § 1.105 to provide:

- a) all user guides directed to the software that embody the invention of claim 35,
- b) a copy of the software embodying the invention of claim 35, and
- c) a copy of the software and user manuals for the 360Risk™ Suite product.

The Assignee will respectfully traverse this request in two ways. First, by noting that the request is not in compliance with the requirements of the Administrative Procedures Act and is therefore moot. Second, by noting that the request exceeds the scope of information the Examiner is entitled to request under 37 CFR §1.105.

As noted previously, the first way the Assignee will respectfully traverse the request for information will be by noting that the request is not in compliance with the requirements of the Administrative Procedures Act and is therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of PTO findings are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Assignee respectfully submits that the instant Office Action fails to provide even a scintilla of evidence to support the allegation that an issue of public use or sales activity has been raised in this application and that as a result it fails to meet the substantial evidence standard. The Assignee respectfully submits that the 12 July 2006 Office Action also fails to pass the arbitrary and capricious test because the Examiner has not provided any evidence of relevant fact finding that can be connected to the request for information contained in the Office Action. The Assignee notes that there are still other ways in which this request for information can be shown to be arbitrary and capricious.

As noted previously, the second way the Assignee will respectfully traverse the request for information will be by noting that the request exceeds the scope of the information that the Examiner is entitled to request under 37 CFR §1.105. 37 CFR §1.105 states that

In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

37 CFR §1.105 goes on to note that in cases such as this where the Assignee has asserted the

right to complete prosecution, the Assignee may be requested to provide:

- i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention,
- (iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention, and/or
- vii) In Use: identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

Given, the above the Assignee respectfully submits that the requests for software exceed the scope of information the Examiner is entitled to request under 37 CFR §1.105. In a similar vein, the Assignee respectfully submits that the request for all user guides or user manuals exceeds the scope of information the Examiner is entitled to request under 37 CFR §1.105. The Assignee further notes that there are no known user guides or user manuals produced by the inventor. The inventor did make a presentation to the Casualty Actuary Society that could be considered non patent literature under the broadest definition of the term. The presentation is available on the Internet (<http://www.casact.org>). The Assignee has not included copies of the presentation as a reference document because it is redundant given prior disclosures. In particular, the presentation repeats information that is available in referenced patents, repeats information that is contained in cited references and contains other information that is redundant with information contained in cited references.

Request for affidavits under 37 C.F.R. 1.104

The 12 July 2006 Office Action appears to be based entirely on opinions that appear to rely on facts in the personal knowledge of one or more employees of the Office. 37 C.F.R. 1.104 provides that:

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

Accordingly, the Assignee requests that an affidavit detailing the facts within the personal knowledge of any employee(s) of the Office that were used to support the statements that:

- a) claims 35 – 68 do not meet the requirements of §112 second paragraph (separate statement for each claim),
- b) an issue of public use or sales activity has been raised in this application,
- c) there is a relationship between the 360Risk Suite and the invention of claim 35,
- d) a restriction requirement is required for claim 39,
- e) a restriction requirement is required for claim 41,
- f) a restriction requirement is required for claim 42,
- g) a restriction requirement is required for claim 43,
- h) a restriction requirement is required for claim 44,
- i) a restriction requirement is required for claim 45,
- j) a restriction requirement is required for claim 46,
- k) the Markush groups in claim 45 and elsewhere are improper, and
- l) a search for the different types of risk typically found in a single commercial enterprise would be burdensome.

The Assignee also requests that an affidavit detailing the facts within the personal knowledge of any employee(s) of the Office that explain why process simulation and process optimization patent applications are classified as class 706 Artificial Intelligence Applications when said applications are filed by large companies and class 705 Business Method Applications when said applications are filed by independent inventors.

It is well established that a prima facie case that a claim does not meet the requirements of §112 second paragraph requires that the claims be interpreted as one of ordinary skill in the art would interpret them. It is also well established that when an invention, in its different aspects, involves distinct arts, the specification is enabling if it enables those skilled in each art, to carry out the aspect proper to their specialty. Accordingly, the Assignee requests that the Examiner identify the arts judged to be contained in the invention described by each claim rejected under §112 second paragraph. The Assignee also requests that the Examiner provide an affidavit containing the name, address, phone number, email address and professional background of each individual providing input to the restriction requirement opinion and the opinions regarding the alleged deficiencies in the claims contained in the 12 July 2006 Office Action. It would be

negligent and a clear abuse of discretion to allow those without the requisite knowledge of the relevant art(s) to provide input to such opinions.

These affidavits are required for inclusion in the appeal that will be filed if the restriction requirement is not removed and the claims are not granted. A failure to provide all the requested affidavits containing all the requested information will be taken as further evidence that the findings in the 12 July 2006 Office Action are arbitrary and capricious.

Objection

The Assignee continues to object to the arbitrary and capricious restriction requirement imposed by the Examiner on the instant application. The Assignee notes that the Examiner has not been able to identify any specific improprieties with a single Markush group. In particular, the Examiner's statement that "the segments of value are of improper Markush format in the at the elements are not art recognized classes" is unintelligible and provides further evidence that the examination of the instant application by an art unit that is not an artificial intelligence art unit has severely compromised the examination process for this application. The Examiner has also failed to articulate why a search for information related to the different types of risk typically found in a single commercial enterprise would be burdensome. The Examiners alleged inability to see the relevance of the dimensionality to the species election raises further questions about the legitimacy of the restriction requirement and the examination as a whole. The Assignee notes again that arbitrary and capricious restriction requirement amounts to a change in the lexicon of the application. The Assignee notes that it is well established that the inventor or assignee is the lexicographer and/or grammarian for an application (W.L. Gore and Associates v. Garlock, Inc. 721 F.2d 1540, 1558, 220 USPQ 303, 316 (Fed Cir. 1983); Fromson v. Advance Offset Plate, Inc. 720 F.2d 1565, 219 USPQ 1137, 1140 (Fed Cir. 1983); Autogiro Co v. U.S., 384 F.2d 391, 197, 155 USPQ 697, 702 (Ct. Cl. 1967). As detailed in one or more cross referenced applications, a matrix of risk is defined by columns and rows where each column represents a segment of value and each row represents type of risk. Along these same lines, a matrix of value is defined by columns and rows where each column represents a segment of value and each row represents an element of value or an external factor that has an impact on one or more segments of value. The restriction to a single segment of value replaces the matrix defined by the Applicant and Assignee with a column and this column would not provide the detail regarding the source of risk or value claimed in the novel invention described by the instant application. The Assignee objects to this attempt to unilaterally change the lexicon used by the Applicant and Assignee to describe unique aspects of the claimed invention.

Given the misguided request for information under 37 C.F.R. § 1.105 and the discussion above, the Assignee respectfully submits that it would also be arbitrary and capricious to rely on the interpretation of the relevant law contained in the instant Office Action when making a decision regarding patentability.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The claims that were pending before the restriction requirement were of a form and scope for allowance. The pending claims are of a form and scope for allowance. Prompt recognition of both is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "B.J. Bennett", with a long horizontal flourish extending to the right.

B.J. Bennett, President Asset Trust, Inc.

Date: December 1, 2006